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IN THE  
**Supreme Court of the United States**  
OCTOBER TERM, 1965

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No. 58

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EDWARD J. BRENNER, Commissioner of Patents,  
*Petitioner,*

v.

ANDREW JOHN MANSON

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On Writ of Certiorari to the United States Court of Customs  
and Patent Appeals

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**BRIEF FOR THE RESPONDENT**

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**BRIEF FOR THE RESPONDENT**

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**OPINION BELOW**

The opinion of the United States Court of Customs and Patent Appeals (R-63) is reported at 333 F. 2d 234, 142 USPQ 35.

**JURISDICTION**

If this Court has jurisdiction, it is under 28 U.S.C. 1256 as alleged in the Petitioner's Brief. (Pet. Br., pp. 1-2.) However, the jurisdiction of this Court to

review a patent decision of the United States Court of Customs and Patent Appeals *upon petition of the Commissioner of Patents* is an issue in this case.

**CONSTITUTIONAL, STATUTORY AND PATENT OFFICE  
RULES OF PRACTICE PROVISIONS INVOLVED**

The applicable provisions are set forth, either in Petitioner's Brief (Pet. Br.) or in the appendix to this brief (Resp. Br.), as follows:

Article I, Section 8, clause 8 of the Constitution of the United States	Pet. Br. p. 2
28 U.S.C. 1254	Resp. Br. p. 61
28 U.S.C. 1255	Resp. Br. p. 61
28 U.S.C. 1256	Resp. Br. p. 61
28 U.S.C. 1257	Resp. Br. p. 61
28 U.S.C. 2601	Resp. Br. p. 62
35 U.S.C. 101	Pet. Br. p. 2
35 U.S.C. 112	Pet. Br. p. 3
35 U.S.C. 134	Resp. Br. p. 63
35 U.S.C. 135	Pet. Br. p. 3
35 U.S.C. 141	Resp. Br. p. 63
35 U.S.C. 144	Resp. Br. p. 63
Rule 131	Resp. Br. p. 64
Rule 204(b), 37 CFR 1.204(b)- [as it read prior to January 1, 1965]	Pet. Br. p. 4
Amended Rule 204(b) and (c), 37 CFR 1.204(b) and (c) [after January 1, 1965]	Resp. Br. pp. 63-64

### THE QUESTIONS PRESENTED

1. Whether this Court lacks jurisdiction, on certiorari sought by the Commissioner of Patents, to review a decision by the United States Court of Customs and Patent Appeals *favorable* to an applicant-appellant in a case arising from the Board of Appeals of the United States Patent Office?

2. Whether, to entitle an applicant for a patent to be placed in interference with a patentee, the requisite *prima facie* case of priority of invention of the claimed patented process has been established under Patent Office Rule 204(b), where the applicant avers he successfully carried out said process for making an old compound before the filing date of the patentee, without regard for the utility of such old compound which had previously been made by a different process?

3. Whether a chemical process is a "useful process," within the meaning of 35 U.S.C. 101, where it produces a *previously* known chemical compound which had been described in an earlier scientific journal article as a member of a group of compounds of great current scientific interest being tested as tumor inhibitors?

4. Whether, in view of 35 U.S.C. 135, a Primary Examiner of the United States Patent Office lacks jurisdiction to decide any question *determinative* of priority of invention as between different parties claiming the same patentable subject matter?

### STATEMENT OF THE CASE

Respondent disagrees in various respects with the factual statement of the case as set forth in Petitioner's Brief, and therefore presents what he considers a correct version.

**(a) Introduction**

All controversy in this case arises in the context of what an applicant for a patent must establish to satisfy Patent Office Rule 204(b), preliminary to the declaration of an interference between his patent application and a prior patent of another.

This case arises from respondent Manson's attempt to contest by an interference proceeding in the Patent Office, priority of inventing the subject matter defined by two claims of his patent application Serial 3 693 (R-3-7, 62) copied from Ringold et al. U.S. Patent 2 908 693 (R-57). The declaration of such an interference would result in a determination by the Patent Office board of patent interferences as to whether Manson or the patentee, Ringold et al., actually was the first inventor of the involved subject matter. Should Manson win the interference, the particular patent claims involved would be automatically cancelled from the Ringold et al. patent (by operation of law under 35 U.S.C. 135) and Manson may then obtain a patent thereon. Should Manson lose, the claims will stand in the Ringold et al. patent.

Holding that Manson had not fully complied with its Rule 204(b), which required the filing of an affidavit stating facts sufficient to establish a prima facie case of priority of invention relative to the filing date of the patentee, the Patent Office refused to declare the requested interference and rejected the claims of the Manson application as fully met by the Ringold et al. patent. However, the Court of Customs and Patent Appeals, ruling that Manson had complied with all preliminaries properly required by law, reversed the Patent Office decision. This means that



if the decision below is permitted to stand, the Commissioner of Patents must institute the interference between Manson's patent application and the Ringold et al. patent and the board of patent interferences determine who first invented the process.

**(b) The Involved Invention**

The invention defined by the patent and the application claims here involved is a *process*.

The chemistry thereof is not material for purposes of this case. The Court may regard the invention simply as: a process for preparing an old substance by reacting two known materials in the presence of a certain catalyst.

The invention here is the "*second*" chemical process discovered for making the substance, 2-alpha, 17-alpha-dimethylandrostan-17-beta-~~ol~~-3-one. For simplicity this substance will henceforth in this brief be referred to as the "2-alpha compound." The 2-alpha compound became publicly known to the scientific community when it was described in a journal article published in November of 1956 (R-59-61). That journal<sup>1</sup> gave full details of the *first* process devised [not here involved] for making the "2-alpha compound" and related compounds. It also described what was being done with the compounds, saying:

"This communication is concerned with the synthesis of a number of 2-methyl and 2,2-dimethyl substituted testosterone and dihydrotestosterone derivatives, compounds of great interest due to the

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<sup>1</sup> The authors of the journal article are Ringold et al., a fact which is immaterial for all purposes of this case, as explained *infra*, p. 53.

discovery that certain members of this series have been found to be massive inhibitors of the development of transplantable rat mammary tumor." (R-59)

\* \* \*

"While anti-tumor screening of the above described 2-methyl hormones is still in progress, Ia and IIa have already been shown to be very effective tumor inhibitors." (R-61)

After the journal article was published, Ringold et al. filed a patent application<sup>2</sup> in Mexico on a completely different *second* process for making the same old 2-alpha compound. Within a year thereafter Ringold et al. filed a corresponding U.S. application which issued as U.S. Patent 2 908 693 on 1959 October 13 (R-57). The patent and the Manson application are concerned *only* with said *second* process for making the same old journal article compounds, including the 2-alpha compound; neither claims the *first* process previously disclosed in the earlier journal article.

#### **(c) Manson's Activities in the Patent Office**

Manson timely filed his patent application Serial 3 693 (R-3) on 1960 January 20, claiming the same new process as claimed by the Ringold et al. patent. Manson also filed concurrently a Rule 204(b) affidavit (R-9) averring he invented the new process prior to the effective filing date of the Ringold et al. patent and asked the Patent Office to declare an interference with the patent.

No objection was made by the Patent Office Primary Examiner to the contents or disclosure of Manson's

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<sup>2</sup> On 1956 December 17.

patent application, but only to the sufficiency of the Rule 204(b) affidavit.

Manson filed additional Rule 204(b) affidavits (R-9, 10, 33, 46, and 47) which, cumulatively, averred that, prior to the 1956 December 17 effective filing date of the Ringold et al. patent, Manson: (a) made the invention described in his patent application; (b) performed all the steps of his claimed process and obtained the 2-alpha compound, had such 2-alpha compound analyzed to establish its identity (all as documented by copies of his laboratory notebook records [R-14-18]); (c) was an expert research chemist experienced in synthesizing steroid compounds in research projects designed to produce new medicinal agents in the field of endocrinology; (d) had read the published journal article; and, (e) averred the utility of the claimed process was obvious to him in that it would produce the 2-alpha compound, the utility of which was also obvious to him, as a hormone analog described in the journal article.

The Examiner regarded the Rule 204(b) affidavits as insufficient to establish a *prima facie* case of invention by Manson prior to the filing date of the patentee, because they: (1) failed to disclose any utility for the 2-alpha compound made by the claimed process; and (2) failed to show the 2-alpha compound was known to have any utility prior to the effective date of the Ringold et al. patent (R-19, 38, 43, 48). Due to the Primary Examiner's refusal to declare an interference between Manson's application and the Ringold et al. patent, Manson's claims were rejected on the Ringold et al. patent. Manson then appealed to the Patent Office Board of Appeals (R-32) under 35 U.S.C. 134.

The Board of Appeals affirmed the Examiner (R-49) for three reasons, saying: (1) the then recently decided case of *In re Dickinson and Zenitz* (CCPA, 1962), 299 F. 2d 954, 133 USPQ 39, which held an allegation in a Rule 204(b) affidavit that the particular named utility of the claimed invention was "obvious" to the inventor, constituted completion of the *prima facie* case for priority of invention, did not apply; (2) the fact the compounds produced by the claimed process may be hormones, and closely related to another hormone shown by the journal article to have utility as a tumor inhibitor, cannot be considered a showing of utility; and, (3) a process is not *prima facie* useful merely because the product made by such process is disclosed in the literature, unless the product was known to be "useful".

**(d) The Decision Below**

Manson appealed to the United States Court of Customs and Patent Appeals (R-54) under 35 U.S.C. 141, which court reversed the decision of the Board of Appeals, the Chief Judge dissenting. The Court below held (R-63): (1) since Manson's process works and is not alleged to be detrimental to the public interest, it is useful; (2) Rule 204(b) is satisfied by an affidavit showing operability of the claimed process to produce a known product, and, there is no additional requirement under 35 U.S.C. 101 that any "use" for such known product be disclosed; and, (3) *In re Dickinson and Zenitz* (CCPA, 1962), 299 F. 2d 954, 133 USPQ 39, which sets forth the Commissioner's duties and responsibilities, is determinative of many of the issues of the instant case; that case is pertinent as to the basic legal right of Manson to have the issue of priority of invention duly determined by the Board

of Patent Interferences as provided in 35 U.S.C. 135, and not by anyone else within the Patent Office; that case is also authority for the proposition the requirement of a *prima facie* showing of utility under 35 U.S.C. 101 may be satisfied by the statement such utility of the known compound was "obvious" at the time the invention was made.

The result of the decision of the Court below is to direct the Commissioner to declare an interference between the Manson application and the Ringold et al. patent.

### SUMMARY OF ARGUMENT

#### (A) Summary of Argument on Jurisdiction

The jurisdiction of this Court to review patent decisions of the Court below, in a case there on appeal from the Board of Appeals of the United States Patent Office, is limited to cases where the review is sought by the patent applicant and, does not extend to cases such as the present where the party seeking review is the Commissioner of Patents.

The legislative history of 28 U.S.C. 1256 bears this out. As originally proposed that section read:

"Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by certiorari granted *on petition of any party* after final judgment." (Emphasis ours)

As promulgated (1948) that section reads:

"Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari."

The omission of the words "on petition of any party" was deliberate, as is clearly apparent by

reference to the legislative history of companion sections. "Any party" does not have the right to seek review. When this section is interpreted in a manner compatible with other related statutes, it is clear the Commissioner of Patents is the party who does not have the right to seek review here.

It is not anomalous that only one party should have the right to seek review of a decision in a patent case from the Patent Office. Review procedure of such cases begins with 35 U.S.C. 141 which grants only the patent applicant, not the Commissioner, the authority initially to appeal an adverse decision of the Patent Office Board of Appeals. After the United States Court of Customs and Patent Appeals renders its decision, 35 U.S.C. 144 forecloses the Commissioner from then asking this Court to review that decision. It provides for a certificate of the decision of the Court below to be returned to the Commissioner, which decision shall "govern the further proceedings in the case."

Since the Commissioner of Patents, ~~who~~ is governed by the decision of the Court below, he may not seek any review which could reverse that decision, and 28 U.S.C. 1256 applies only to a patent applicant party.

#### **(B) Summary of Argument on the Merits**

The basic and only proper question in this case is whether there was compliance with Rule 204(b), which is concerned only with *prima facie* proof of priority of invention. Contrary to Petitioner's statement of the issues, because the process on which Manson seeks a patent has already been patented in the Ringold et al. patent, no question of its patentability can possibly

be involved. Because no question of the "utility" disclosure necessary to *support* Manson's patent application was ever raised by the Primary Examiner (R-39), this can not give rise to any issue in the case either:

Initially, this Court ought decide who, within the Patent Office, could lawfully adjudge the legal sufficiency of Manson's Rule 204(b) affidavits to establish the requisite priority of invention since, if the wrong body did so, Manson's affidavits can not thereby be held legally insufficient. The applicable statute, 35 U.S.C. 135, provides

" . . . the question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) . . . ."

The Primary Examiner and the Board of Appeals, who adjudged Manson's affidavits and found them insufficient to establish priority of invention under Rule 204(b), legally had no right so to do. In effect this illegality was admitted by Petitioner when the Patent Office recently amended Rule 204 so that, today, a Primary Examiner considers the affidavits submitted only to the extent of determining whether a date prior to the filing date of the patentee is alleged, and if so, he declares the interference and turns the entire file over to the interference division which then makes the legal determination of whether the affidavits establish a *prima facie* case of priority of invention.

Moreover, Manson actually did comply with all the requirements of Rule 204(b). He *prima facie* established priority of invention by the criterion this Court



set forth in *Corona Cord v. Dovan* (1928), 276 U.S. 358, 383:

"A process is reduced to practice when it is successfully performed."

Manson showed he had completed his invention (reduced it to practice) prior to the Ringold et al. filing date, by establishing he had successfully performed the claimed process to make the 2-alpha compound it is supposed to make. This alone was sufficient to comply fully with the requirements of Rule 204(b).

Manson does not claim to have invented the 2-alpha compound, but only a second process for making it. Whether the 2-alpha compound had a known utility is immaterial to the process invention itself. The various statutory types of invention must not be confused. This Court has long distinguished between a process and a product made therefrom, and considered them independent of each other. It is not necessary in order to prove completion of a "process" invention, also to prove completion of a "composition of matter" (product) invention. Here the process invention was completed when it was successfully performed and the compound made thereby was identified as the 2-alpha compound. These acts by Manson also established the process was useful since it worked to produce the desired product (no matter why that product might have been desired). The Court below properly held Manson could and did establish a *prima facie* case of completion of the act of inventing his process without regard to whether the 2-alpha compound produced had a known utility.

Actually, Manson's claimed process does make a compound with a known utility. The 2-alpha com-



pound clearly would be held to be useful under 35 U.S.C. 101 by the Court below. The particular "use" in question is that made known to the scientific community in the journal article, i.e., that the 2-alpha compound is a member of a group of steroid and hormone analog compounds of great interest due to the discovery that certain members of the series have been found to be massive inhibitors of the development of transplantable rat mammary tumor, and anti-tumor screening of various of the compounds is still in progress, including the 2-alpha compound. This type of utility is sufficient to comply with 35 U.S.C. 101 under a viable precedent, *In re Nelson et al.* (CCPA, 1960), 280 F. 2d 172, 126 USPQ 242.

Manson's process is clearly "useful" as that term is defined in patent law, where it is a term of art, differing from the general conversational connotation of the word. Anything which is not frivolous or worthless or injurious to the well being and morality of the public, and which works is "useful." Manson's process invention, which resulted in a second or alternative way to make the 2-alpha compound, is a contribution to scientists working in this area. Furthermore until comparatively recently the Patent Office itself considered that all chemical compounds were inherently useful, since they can always be used to prepare other compounds. Thus the recent decisions of the Court below do not change the law, but only return it to that applied for so many years successfully to promote the progress of science and the useful arts in this country.

Petitioner's Brief confused the Ringold et al. journal article with the Ringold et al. patent, and also failed to recognize that Ringold et al. made two separate

process inventions; one being the first process of the journal article, and the second being the alternative process of the patent. Manson only seeks to contest priority of the latter alternative process invention. Manson need not show that he made this patented alternative process invention prior to the time Ringold et al. made the first process invention.

Affirmance of the decision below will best serve the objectives for which the patent system was established by promoting earlier disclosure and discouraging secrecy. Inventors will not publish details of their discoveries if doing so will jeopardize their property rights. If a chemist not only has to invent a process for making a new compound, but then must also invent a use for that new compound, it will be much later, if ever, that the process details are made public.

## ARGUMENT

### (A) ARGUMENT ON JURISDICTION

- I. **This Court Has Jurisdiction Under 28 U.S.C. 1256 to Review Patent Decisions of the Court of Customs and Patent Appeals Except Where, as Here, Review Is Sought by the Commissioner of Patents**

In *Glidden Company v. Zdanok*, 370 U.S. 530, 578, footnote 49, 8 L. ed. 2d 671, 704, this Court left open the question of its jurisdiction to review certain decisions of the Court of Customs and Patent Appeals, saying:

“We intimate no opinion whether 28 USC Sec. 1256 was intended by Congress to make patent and trademark cases reviewable by certiorari in this Court. See Kurland and Wolfson, Supreme Court Review of the Court of Customs and Patent Appeals, 18 GWL Rev. 192, 194-198 (1950).”

Respondent, Manson, believes, as does Petitioner, this Court today has jurisdiction to review on cer-

tiorari a decision by the United States Court of Customs and Patent Appeals in a case there on appeal from the Board of Appeals of the United States Patent Office.<sup>3</sup>

However, Respondent only partially agrees with Petitioner. Contrary to Petitioner's position, Respondent submits this jurisdiction is limited to cases where the review is sought by the patent applicant, and does not extend to cases where the party seeking review is the Commissioner of Patents, as in the instant case. Respondent submits this is the Congressional intent as shown by consideration of the legislative history.

Respondent will not here repeat the portions of Petitioner's Brief, with which it agrees and endorses, i.e., that part which reviews factually the history of this Court in considering whether it has jurisdiction to review decisions of the Court of Customs and Patent Appeals and details factually the various statutory changes which have occurred since this Court last considered the question. Respondent will deal only with those areas where it disagrees with Petitioner.

## **II. The Congressional Intent Was to Not Allow Review Under 28 U.S.C. 1256 "On Petition of Any Party"**

The intent of Congress, to limit review by this Court of decisions of the Court of Customs and Patent Appeals in *ex parte* patent cases solely to instances

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<sup>3</sup> Respondent's reasons, and an exposition of the background of the jurisdictional problem, are detailed in R. J. Gilbert "The Constitutionality of Supreme Court Review of Patent and Trademark Decisions of the Court of Customs and Patent Appeals," 48 T.M.R. 8-17 (1958); Stern and Gressman "Supreme Court Practice," 3rd ed., 1963, pages 56-60; and, especially J. P. McDonnell "Certiorari to and the Constitutional Status of the Court of Customs and Patent Appeals," 45 J.P.O.S. 704-715 (1963).

where review is sought by the patent applicant, can be seen by comparing the language of the companion statutes granting jurisdiction to this Court to review cases from various other courts and from the Court of Customs and Patent Appeals, and noting the differences in language stating who can ask this Court for review.

28 U.S.C. 1254, dealing with review of cases from the courts of appeal of the circuits, provides:

“Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:  
(1) By writ of certiorari granted upon a petition of *any party* to any civil or criminal case . . .”  
(Emphasis ours)

28 U.S.C. 1255, dealing with review of cases in the Court of Claims, provides:

“Cases in the Court of Claims may be reviewed by the Supreme Court by the following methods:  
(1) By writ of certiorari granted upon petition of *the United States or the claimant*; . . .”  
(Emphasis ours)

28 U.S.C. 1256, dealing with review of cases in the Court of Customs and Patent Appeals, with which we are concerned, provides:

“Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.”

The latter statute does not spell out who can petition for the writ, contrary to the preceding companion statutes which specify that *any party* can petition.

This difference in language is deliberate, as clearly shown by the legislative history of this section. The words “on petition of any party” *were present in the*

*preliminary drafts* of 28 U.S.C. 1256 prepared as part of the codification of the Judicial Code (which occurred in 1948), but were subsequently deleted.

A study of the legislative history shows that in the first four drafts in 1945 and 1946, the then proposed section 1256 read:<sup>4</sup>

"Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by certiorari granted on petition of *any party* after final judgment." (Emphasis ours)

However, in all subsequent drafts and documents, beginning with HR 7124 on July 24, 1946, the language of section 1256 read as it now does, i.e., the "on petition of any party" language no longer appeared.

Undoubtedly the deletion of the "on petition of any party" provision occurred as a conscious result of

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<sup>4</sup>The legislative history may be conveniently found in the Supreme Court library in a three-volume set, entitled "Legislative History, Title 28, U.S. Code," made up of pamphlets and booklets bound together.

The above-quoted language containing the words "on petition of any party" was present at page 230 of the Committee Print printed in 1945 for the use of the Committee on Revision of the Laws, House of Representatives, entitled "Revision of Federal Judicial Code"—Preliminary Draft—with Reviser's notes. The identical above-quoted language was still present at page 69 of a pamphlet "U.S. Code, Revision of Title 28, Judiciary and Judicial Procedures, applicable to the Supreme Court of the United States, 1945" which was prepared at the direction of the Committee on Revision of the Laws of the House of Representatives especially for the Judicial Conference Committee on Revision of the Judicial Code, appointed by the Chief Justice of the United States. The above-quoted language was still present at page 236 of a printed pamphlet entitled "U.S. Code, Revision of Title 28, Judiciary and Judicial Procedure, Fourth Draft, meeting April 1-3, 1946, Washington, D. C.

action taken at the April 1-3, 1946 meeting (referred to in footnote 4). The meeting was of an Advisory Committee made up of various leaders of the Judiciary, of the Bar, of the Judicial Conference, and of the Supreme Court.<sup>5</sup>

The significance of the deliberate omission of the "on petition of any party" language from 28 U.S.C. 1256 becomes even more apparent from the parallel legislative history of companion section 1255 dealing with review of cases in the Court of Claims. Prior to the aforementioned meeting of April 1-3, 1946, this section read that such cases may be reviewed:

"(1) By writ of certiorari granted on petition of any party."

After that meeting, this section read, as it now does, that such cases may be reviewed:

"(1) By writ of certiorari granted on petition of the United States or the claimant."

This language change indicates a definite concern over who can seek review in the Supreme Court and emphasizes the omission of "on petition of any party" from Section 1256 was truly a deliberate act and not a mere inadvertence.

Another companion section, 28 U.S.C. 1257, dealing with how cases from state courts may be reviewed by the Supreme Court, also does not specify who can properly ask for review. While we find no cases in point under this statute, in cases under predecessor

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<sup>5</sup> Respondent's attorneys were recently informed by Dr. Zinn, the then counsel for the Committee on Revision of the Laws of the House of Representatives, that the Advisory Committee purposely never published any minutes or otherwise explained its actions.

statutes to section 1257 this Court has held that "any" party does not necessarily have the right to seek review here. For example, in *Morgenthau v. Stephans* (1935), 294 U.S. 720, 55 S. Ct. 542, which involved a situation where the judgment sought to be reviewed was joint, and there was no summons and severance of record, a party was not allowed to ask for review. This is another indication failure to spell out who can ask for review in the jurisdictional statute means not all possible parties can seek review.

An argument might be made that failure of the statute to spell out who can ask for review means no party can. This would be specious reasoning, since the statute would then have no effect when it was obviously intended by Congress to have some effect.

While it is clear from the legislative history some party was granted the right to petition for review, what is not so clear is whether the patent applicant and the Commissioner of Patents each was granted the right to ask for such review. Respondent bottoms his contention that the right to petition for review is his alone, on the peculiar facts of life in patent law and practice. In proceedings on patent applications, the right of only one of two parties to obtain review is not unusual, so it is not anomalous that only one of the two parties to the case below could now have the right to seek review by this Court of an adverse decision. In fact the patent statutes necessitate that result.

Patent appeal procedure begins with 35 U.S.C. 134 which provides:

"An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals . . ."



Thereafter, the next here applicable statute is 35 U.S.C. 141 which provides:

“An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals . . .”

Thus, statutory authority to appeal is limited to an *applicant* for patent. The Commissioner cannot so do.

Petitioner argued (Pet. Br., p. 17):

“Obviously the Patent Office may not contest the propriety of its own judgment by seeking review in the Court of Customs and Patent Appeals. That fact, however, surely does not preclude the Patent Office from seeking review in this Court of an adverse judicial decision rendered in review of its order, if certiorari jurisdiction, as we submit, otherwise exists. See, e.g., *Consolidated Foods Corp.*, 380 U.S. 592; *Securities and Exchange Commission v. Chenery Corp.*, 332 U.S. 194; *National Labor Relations Board v. Hearst Publications, Inc.*, 332 U.S. 111.”

The Petitioner's argument is not applicable here. The specific cases cited by Petitioner indicate only that various administrative agencies have the right to seek review here of an adverse judicial decision reversing their order. In the specific cases the agencies were the Federal Trade Commission, the Securities and Exchange Commission and the National Labor Relations Board. Note in those cases the agencies were seeking review from decisions of a *Court of Appeals*, as to whose decisions 28 U.S.C. 1254 specifically grants “any party” the right to petition for review. Further, in those cases the Board or Commission seeking review was the exact entity which rendered the initial decision appealed to a Court of Appeals. That is not the situation here.



What Petitioner fails to recognize is that "the Commissioner of Patents" and "the Patent Office" are not synonymous. Within the Patent Office, the particular tribunal which rendered the decision appealed to the Court below, is the Board of Appeals. The members of the Board of Appeals are the Commissioner, the assistant commissioners and the examiners-in-chief, all of whom are appointed by the President (35 U.S.C. 3 and 7). The Board of Appeals, by statute, hears appeals in panels of at least three members. While the Commissioner of Patents is a member of the Board of Appeals he is not *the* Board of Appeals. Thus the Petitioner is inaccurate in arguing that the reason the Commissioner cannot appeal to the Court of Customs and Patent Appeals is because the Patent Office would thereby be contesting the propriety of its own judgment. The reason is: the statute, 35 U.S.C. 141 precludes it.

Furthermore, 28 U.S.C. 1256 ought to be interpreted in a manner compatible with other related statutes.

While it is speculation, a reasonable explanation can be advanced the elimination of the phrase "by any party" was prompted in view of a conflict arising with 35 U.S.C. 144 which provides the lower court shall advise the Commissioner of its decision and such decision "... shall govern the further proceedings in the case." If the Commissioner is "governed" by the decision as to further proceedings, a review statute under which the Commissioner could petition to this court, would conflict with Section 144.

35 U.S.C. 144 reads:

"The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before

the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court *shall return to the Commissioner* a certificate of its proceedings and decision, *which shall be entered of record in the Patent Office and govern the further proceedings in the case.*" (Emphasis ours)

That section says the decision of the Court of Customs and Patent Appeals shall be returned to the Commissioner and shall govern the further proceedings in the case. It is submitted that section does not permit the Commissioner to attempt to have the decision reversed.

Note the difference between the statutory language in patent cases, and that in customs cases, where 28 U.S.C. 2601 contemplates review by this Court and provides:

"*Any party to a proceeding before the Customs Court who is dissatisfied with the decision of such court . . . may . . . apply to the Court of Customs and Patent Appeals for a review of all questions of law and fact . . .*

"*. . . The decision of the Court of Customs and Patent Appeals shall be final unless set aside or modified by the Supreme Court, and the case shall be remanded to the Customs Court for further proceedings to be taken in pursuance of such decision.*"

Respondent submits that, in view of the foregoing statutes, the sounder view is the Commissioner of Patents has no right to seek review of Court of Customs and Patent Appeal cases, and a petition by the Commissioner of Patents does not give this Court jurisdiction over the instant case under 28 U.S.C. 1256.

**(B) ARGUMENT ON THE MERITS****I. Introduction**

There is a wide disparity between the viewpoints of Petitioner and Respondent, Manson, as to the merits issues involved in this case. Manson will show the governing facts and setting of this specific case preclude any decision on the particular question Petitioner's brief presented. We ask the Court to be especially conscious of semantics and the precision of language required in patent cases<sup>6</sup> where the same word may have different meanings depending on the context and circumstances.<sup>7</sup>

**II. There Is No "Patentability" Issue Involved Since Manson's Claimed Process Has Already Been Held to be Patentable**

Petitioner mistakes the question in this case, when it said:

"On the merits, the question in this case concerns the meaning of the utility requirement for patentability in the Patent Act." (Pet. Br., p. 17.)

There is no issue of the utility<sup>8</sup> requirement for patentability; there cannot be any real issue involving

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<sup>6</sup> Patent law has been called "the metaphysics of the law." Justice Story in *Barrett et al. v. Hall et al.* (C.C. Mass., 1818) Fed. Case No. 1047, 2 Fed. Cas. 914, 923.

<sup>7</sup> For example: Distinguish carefully two meanings of the word "invention". In the phrase "priority of invention" it means priority of the acts of conceiving and embodying physically the claimed subject matter. In the context of "the invention" it means the mental concept defined by the claim of an application or patent.

<sup>8</sup> See pp. 49-53, *infra*, on the meaning of the words "utility" and "useful" in Patent Law.

any aspect of the patentability of Manson's claimed process. It is certainly "patentable," since it is patented. The existence of the Ringold et al. patent (which claims the same process) is the unassailable, unimpeachable proof that all requirements for patentability of the process have been satisfied. No matter what happens in this law suit, the process which Manson here claims will remain patentable and patented, either to Manson or to Ringold et al.

Petitioner further mistakes the nature of the question in this case, when it went on to say:

"Specifically, it calls for a decision of the showing of utility which must be made to support an application for patent . . ." (Pet. Br., p. 17.)

No "showing of utility" to *support* Manson's patent application was ever required by the Patent Office. The Examiner himself specifically pointed this out, saying:<sup>9</sup>

"It should be further noted that although there is no disclosure in the involved application showing the utility of the compounds produced by the processes recited in the appealed claims, this omission is not fatal to applicant's cause since the utility of same was known *prior* to the time the instant application was filed. See column 1, lines 17-26 of the Ringold et al. patent which issued October 13, 1959, three months prior to the filing date of the involved Manson application." (R-39)

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<sup>9</sup> Patent specifications are addressed to those skilled in the art. Whatever is published is known to those skilled in the art and so need not be actually disclosed in a specification. It constitutes unwritten disclosure. This doctrine goes back to *Loom Co. v. Higgins* (1881), 105 U.S. 580, 586: "That which is common and well known is as if it were written out in the patent . . ."

Accuracy in determining the true issues in the case is necessary because the Court below could not apply any "new ground of rejection" such as would be involved in any rejection of the Manson application for lack of patentable utility or of inadequate disclosure thereof, since the Manson application was not rejected by the Patent Office on any of these grounds. The Court of Customs and Patent Appeals has so interpreted its own jurisdiction since its very early days, *In re Tucker* (CCPA, 1932), 54 F. 2d 815, 12 USPQ 131. The same is true today.<sup>10</sup>

Petitioner errs in asserting or inferring the existence of any issue in this case based on the content or lack of content of Manson's patent application.

There is no "patentability" issue in this case based on the disclosure or lack of disclosure of Manson's specification, i.e., no issue involving 35 U.S.C. 112 requirements.<sup>11</sup> Theoretically it would be possible to have a situation where a patent application claims the same patentable subject matter as an issued patent, but where the patent application does not comply with all the statutory prerequisites, and so could not properly issue as a patent. Such a situation could have arisen had Manson merely claimed the instant process,

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<sup>10</sup> *In re Nygard* (CCPA 1965), 341 F. 2d 924, 928, 144 USPQ 586, 590:

"This court is a court of *review* and reasons for rejection not made in the Patent Office are not properly before us."

Additional cases in point are collected in a note "The Scope of Review of the Court of Customs and Patent Appeals: Time for a Change?" 33 Geo. Wash. L. Rev. 955-974 (1965).

<sup>11</sup> Petitioner's arguments (Pet. Br. pp. 26, 33) based on 35 U.S.C. 112 refer to a section of the patent statute not here involved.

but failed to describe it properly in his specification. That type of situation is not here involved. There has never been any objection by the Patent Office to the Manson specification.

What then is the "patentability" issue? The answer: there is none! There is only an issue of compliance with Rule 204(b). Rule 204(b) is concerned only with prima facie proof of priority of invention. The so-called "patentability" issue is now exposed as one of whether "priority of invention" has been adequately proven to comply with the rule.

The actual issues in this case revolve around Rule 204(b), as to when and how its requirements have been satisfied.

### **III. The Primary Examiner Had No Right to Question the Adequacy of Manson's Rule 204(b) Affidavits But Had to Declare the Requested Interference**

There is an issue in this case, completely ignored by Petitioner, which must be determined BEFORE the other merits issues in the case can be reached.

When Manson, seeking to provoke an interference with the Ringold et al. patent, filed his Rule 204(b) affidavits, questions arose as to whether there was compliance with the rule. Rule 204(b) then provided

" . . . [applicant] shall file an affidavit . . . that his acts . . . with respect to the invention were sufficient under the law to establish priority of invention relative to the filing date of the patentee; and, when required the applicant shall file an affidavit (of the nature specified in rule 131) setting forth facts which would prima facie entitle him to an award of priority relative to the filing date of the patentee."

The question this Court must decide is: just *who*, within the Patent Office, could lawfully adjudge the legal sufficiency of Manson's Rule 204(b) affidavits to establish the requisite priority of invention? If the wrong body did so, then Manson's affidavits cannot be held legally insufficient.

It was the Primary Examiner who initially adjudged Manson's affidavits (R-19, 39, 48), saying at R-39:

"The above identified affidavit under Rule 204(b) is insufficient to establish priority of invention relative to the filing date of the patentee."

The decision of the Primary Examiner was reviewed by the Board of Appeals, which said at R-53:

"For the above reasons, we conclude that the affidavit under Rule 204(b) is not sufficient to establish a *prima facie* case of a reduction to practice of the process of claim 3 . . ."

The Primary Examiner and the Board of Appeals, in adjudging the sufficiency of Manson's affidavits to determine whether Manson's acts were sufficient to establish priority of invention relative to the filing date of the patentee, necessarily made a determination of priority of invention. This they had no right to do. The applicable statute, 35 U.S.C. 135, is very clear that:

". . . The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) . . ."

The "board of patent interferences" is not the Primary Examiner or the Board of Appeals or the Commissioner of Patents, but a different body.<sup>12</sup>

<sup>12</sup> See Appendix at p. 65, *infra*.



Manson continually protested and argued the Primary Examiner's lack of jurisdiction to determine reduction to practice and priority of invention questions. Manson unsuccessfully protested to the Primary Examiner (R-24), to the Commissioner of Patents on petition (R-36) and to the Board of Appeals (R-51). All took the view that the Primary Examiner was not really deciding priority, but was merely conducting certain preliminary investigations, which he was entitled to make, prior to the instigation of an interference proceeding. All were wrong.

The Court below reversed, citing its reasoning in *In re Dickinson and Zenitz* (CCPA, 1962), 299 F. 2d 954, 133 USPQ 39, as being directly in point. The Court below (R-65) recognized the Primary Examiner actually was making a determination of priority of invention, although disguising it under another name. The Court below recognized that the patent statute, 35 U.S.C. 135, specifically provides who shall make such determinations of priority of invention and that, in this case, the determination was not made by the particular body statutorily charged with that job. Naturally if a statute affirmatively sets forth who shall judge priority of invention, the negative pregnant is that no one else may so do.

Petitioner, by the arguments made and questions posed in his brief, in effect is asking this Court to make the same determination of priority of invention as the Primary Examiner made. But just as 35 U.S.C. 135 forecloses the Primary Examiner, so is this Court foreclosed.<sup>13</sup>

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<sup>13</sup> At a proper time, this Court will be able to reach such questions. But not at the present Rule 204(b) posture of this case, before any interference has been declared, much less decided.



If the Primary Examiner lacked jurisdiction initially to make such determination, this Court cannot here review the correctness of his decision. Else Manson will be deprived of his basic legal right to have the issue of priority of invention duly determined as provided by the statute.

Petitioner's brief never alludes to the above reasoning, which independently supports the decision of the Court below. Moreover, Petitioner, the Commissioner of Patents, has even amended Rule 204(b)<sup>14</sup> so that today the Patent Office procedure complies with the reasoning of the Court below. The propriety of the decision below becomes even more evident by contrasting the practices followed by the Patent Office in Rule 204(b) situations.

At the time the instant case arose, the procedure in the Patent Office was for the Primary Examiner [or his assistant] to examine a newly filed patent application to see if it fulfilled the various formal requirements which the law specifies for any patent application. If the application was found to be otherwise allowable, save for the existence of an interfering application or patent, then the Primary Examiner asked the junior interfering applicant to state under oath his earliest date of conception, since if the junior party could not aver a date earlier than the senior party's filing date there was no point in having an interference. This was because, if there was no possible way the junior party could win, there would be no actual priority question raised and no point in

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<sup>14</sup> Amended Rule 204(c): "... the examiner ... will consider this material [set forth in the affidavit] only to the extent of determining whether a date prior to the effective date of the patentee is alleged, and if so, the interference will be declared."

declaring an interference. For example if Manson did not allege he made his invention before Ringold et al.'s filing date, he could never win the interference under any circumstances. No actual question of priority of invention had to be determined in such a situation, since all that is involved is a simple comparison of a filing date (which is a matter of record) versus an alleged date. No one disputes the Primary Examiner could and still can do this much.

In the instant case, in order to determine whether there ought be an interference, the Primary Examiner went beyond this and made certain legal determinations involving disputed views of the law involving priority. This the Primary Examiner cannot do.

Since the decision below was rendered, and effective as of January 1, 1965, the Patent Office has changed its rules and practice as to what a Primary Examiner can decide preliminary to the declaration of an interference. Today under new Rule 204(b) and 204(c) (*infra*, p. 63), a Primary Examiner may consider the affidavits submitted only to the extent of determining whether a date prior to the effective filing date of the patentee is *alleged*. If so, he declares the interference, and turns the entire file over to the Interference Division which then makes the determination of whether or not the affidavits state a *prima facie* case of priority.

This change in Rule 204(b) was clearly made in view of the decisions of the Court below in the instant case, and in *In re Dickinson and Zenitz* (CCPA, 1962), 299 F. 2d 954, 133 USPQ 39, and seems to be an admission of the correctness of the holding below, especially since Petitioner has not raised it as an issue in this case.

If this Court finds the Court below was correct in holding that the Primary Examiner had no proper authority to make a determination of priority of invention, it need not reach the other issues in this case.

#### **IV. Manson Complied With All the Requirements of Rule 204(b)**

Since compliance with Rule 204(b) is the keystone to this case, we shall in this brief analyze the various elements of the rule, including related rules and statutes, to see how they can be satisfied, so we can later show they actually were satisfied in this case.

In pertinent part Rule 204(b) requires:

“ . . . before an interference will be declared, [the applicant] shall file an affidavit . . . that his acts . . . with respect to the invention were sufficient under the law to establish priority of invention relative to the filing date of the patentee; and, when required, the applicant shall file an affidavit (of the nature specified in Rule 131) setting forth facts which would *prima facie* entitle him to an award of priority relative to the filing date of the patentee.”

The type of affidavit specified in Rule 131, and which is required by Rule 204(b), is one in which the affiant

“ . . . shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued . . . ”

and wherein

“The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference . . . ”.

Rule 204(b) is related to 35 U.S.C. 102(g) which says

“ . . . in determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, . . . ”.

**A. MANSON PRIMA FACIE ESTABLISHED “PRIORITY OF INVENTION” BY REDUCING HIS INVENTION TO PRACTICE BY THE CRITERION THIS COURT SET FORTH IN CORONA CORD v. DOVAN**

“Priority of invention” is simply a question of deciding who was the first to invent the claimed subject matter. Under United States law, only the “first inventor” is entitled to the patent, without regard for who was the first to file a patent application. A key factor in determining priority of invention is the date of “reduction to practice” of the claimed invention.

“Reduction to practice”<sup>15</sup> refers to the completion of the invention, which began as an idea, by physically applying that idea to the production of a tangible result. It is the act of reducing the invention from a mental concept to a tangible form.<sup>16</sup> There are two kinds of reduction to practice. One is “constructive” reduction to practice; this occurs when a patent application disclosing the invention is filed. The other kind is “actual” reduction to practice; it generally involves the establishment of a successful performance or demonstration of the claimed inven-

<sup>15</sup> For a general discussion of “reduction to practice” see Deller’s Walker on Patents, 2nd ed. 1964, sec. 46, pages 199-210.

<sup>16</sup> *Clark Thread Co. v. Willimantic Linen Co.* (1891), 140 U.S. 481, 489:

“A conception of the mind is not an invention until represented in some physical form, . . . ”

tion. This can vary according to the type of invention involved.

We are here concerned with the question of when Manson completed the actual reduction to practice of his claimed invention. This court had occasion to discuss when an actual reduction to practice of a process has been accomplished in *Corona Cord v. Dovan* (1928), 276 U.S. 358, 383, saying:

“A process is reduced to practice when it is successfully performed. A machine is reduced to practice when it is assembled, adjusted and used, a manufacture is reduced to practice when it is completely manufactured. A composition of matter is reduced to practice when it is completely composed. Walker on Patents, Section 141(a); *Hunter v. Stikeman*, 13 App. D.C. 214, 226; *Mason v. Hepburn*, 13 App. D.C. 86, 92; *Lindemeyr v. Hoffman*, 18 App. D.C. 1, 5; *Roe v. Hanson*, 19 App. D. C. 559, 564.”

In the instant case the acts alleged in the various affidavits Manson filed are sufficient “prima facie” to entitle him to an award of priority relative to the filing date of the patentee. The various affidavits establish Manson’s claimed process was successfully performed (to make the 2-alpha compound it is supposed to make) earlier than the filing date of the Ringold et al. patent.

We point out that the Court should not attempt to determine whether Manson actually will win the interference which will ultimately be declared with the Ringold et al. patent. Rule 204(b) says only an affiant must aver facts which will—

“... prima facie entitle him to an award of priority.”

The term "prima facie" is defined in Black's Law Dictionary, third edition, as

"at first sight; on the first appearance; on the fact of it; so far as can be judged from the first disclosure; presumably."

The presence of the term "prima facie" affects the affidavit statements and proofs required by Rule 204(b). The burden on Manson is not the same as it might be after the interference has been declared and all the proofs have been presented, when the case is ready for final determination. *Certainly to establish the right to be a contestant in an interference, less is required than to establish the right to win the interference after declaration. In re Dickinson and Zenitz (CCPA, 1962), 299 F. 2d 954, 958, 133 USPQ 39, 43.*

Using this definition, all Manson had to do to comply with Rule 204(b) was to make out by affidavit a case which presumably would be legally sufficient if all the facts alleged are true. The situation is similar to what a trial court, in a civil action, must consider when faced with a motion to dismiss a complaint. It takes the facts alleged, assumes them all to be true, and ascertains whether, under any possibly applicable law, a cause of action has been stated.

The Examiner and the Board of Appeals had no right to question any of the facts averred by the Manson affidavits; and must accept them. Whenever these facts evidence an actual reduction to practice under the doctrine of any viable case stating the minimum standards or requirements for an actual reduction to practice, the requisite *prima facie* case of priority of invention is established. Later on, during the interference testimony period, the opposing party, if it can,

may show by cross-examination and rebuttal testimony that there are other circumstances which change the "facts" of the affidavit so that the particular decision relied upon for the establishment of a *prima facie* case no longer applies. But this comes later, and is not the concern of the Primary Examiner, or of the Board of Appeals, or even of this Court.

The allegations of Manson's various affidavits, when accepted as facts, as they must be at the Rule 204(b) present stage of the proceedings, are sufficient to constitute actual reduction to practice, under the doctrine of *Corona Cord v. Dovan* (1928), 276 U.S. 358, 383, where this Court set the criterion as:

"A process is reduced to practice when it is successfully performed."

This Court there was concerned with ascertaining whether the patentee, Weiss, or someone else, Kratz, was the prior inventor of the claimed process for vulcanizing rubber. This Court pointed out both Kratz and Weiss founded their claims of invention on cured slabs of rubber which had been vulcanized, rather than having made anything truly practical out of the rubber. The Court said at page 373:

"It now appears, without contradiction, that the only rubber Weiss made during the early part of the year 1919 from D.P.G. was test slabs of rubber in which D.P.G. was the accelerator, and that in fact neither he nor anybody in the Rubber Company had vulcanized rubber goods, as Daniels described them, before the Kratz publication. But we do not think this would invalidate the patent, for the reason that the actual fact was that these test slabs of rubber with D.P.G. if proven to be properly vulcanized, as the evidence seems to show, were a demonstration of the utility of D.P.G. as an

accelerator and were a completed and demonstrated discovery constituting reduction to practice. Production of rubber-goods for use or sale was not indispensable to the granting of the patent."

The Court said at page 384:

"It is a mistake to assume that reduction to use must necessarily be a commercial use. If Kratz discovered and completed, as we are convinced that he did, the first use of D.P.G. as an accelerator in making vulcanized rubber, he does not lose his right to use this discovery when he choses to do so, for scientific purposes or purposes of publication, because he does not subsequently sell the rubber thus vulcanized, or use his discovery in trade . . ."

The various affidavits and exhibits filed on behalf of Manson to meet the requirements of Rule 204(b) are printed in the record at R-9, 10, 33, 46 and 47; we summarized them at page 7 of this brief. The Board of Appeals discussed them, saying:

"It does not appear that the Examiner questions the affidavits filed under the provisions of Rule 204(b) except as to the showing relative to the utility of the compounds produced by the process of Claim 3. The issue presented is whether the affidavits are sufficient in the [sic] respect."  
(R-50)

It is undisputed these affidavits show Manson did actually carry out his claimed process and did use it to make the 2-alpha compound prior to the filing date of the Ringold et al. patent. His successful performance of the process constitutes the requisite *prima facie* completion of the claimed invention prior to the Ringold et al. filing date in full compliance with Rule 204(b).



**B. MANSON COULD AND DID COMPLETE HIS PROCESS INVENTION, WITHOUT REGARD TO WHETHER THE KNOWN COMPOUND PRODUCED HAD A KNOWN UTILITY**

(1) Petitioner infers that no patentable invention can be completed until a use<sup>17</sup> is found. Manson's position is that the 2-alpha compound produced by his process had a known utility.<sup>18</sup> However, Manson could complete his invention without regard to whether or not the 2-alpha compound was known to be useful by completing the requisite tests. In considering when an invention has been completed the Court must be cognizant of the peculiarities of the particular type of invention involved. 35 U.S.C. 101 states the various statutory types of invention which could be patentable and so conceivably could be involved, as: "machines," "manufactures," "compositions of matter" and "processes." The reason for the application of any "utility requirement" or of any test requirement for an actual reduction to practice may vary with the invention, so it becomes important to know the underlying philosophy, which we will now discuss.<sup>19</sup>

When has a claimed "invention" been completed and actually reduced to practice? We submit the answer is: When it is known that the physical embodiment of the "invention" is what it purports to be. A test may or may not be required to demonstrate this completion of the invention, depending upon the exact subject-matter, its statutory class, and the apparency of what it will do. Sometimes an invention can be

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<sup>17</sup> See pp. 49-53, *infra* for a discussion of the meaning of "use".

<sup>18</sup> See pp. 44-49, *infra*.

<sup>19</sup> See Note "The Legally Complete Invention—A Study of the Requirement of Testing to Establish An Actual Reduction to Practice", 33 Geo. Wash. L. Rev. 740-763 (1965).

completed without an actual test because it is obvious that it will work for the purpose which is a part of its name, so that testing is superfluous. We will now apply this reasoning to various statutory classes of subject-matter.

Consider a new *machine*, for example, a "pencil sharpener." By definition, a "pencil sharpener" is a device that sharpens pencils. No assembly of machine elements that can not sharpen a pencil can be said to be a pencil sharpener. The only way one can know whether a particular machine is or is not a pencil sharpener is to try to sharpen a pencil with it. Thus to know whether a particular machine is what it purports to be, it is necessary to *use* it for the purpose which is a part of its name. Until this has been done the invention has not been completed. That is the type of use or test necessary.

Some other illustrative examples are: (1) a heater; until one knows whether it is capable of heating, a new device cannot be called a heater, and (2) a stapler; until one knows whether it can staple things together, a new device cannot be considered a stapler.

*Compositions of matter* inventions may, in some instances, differ from machine inventions in that the name sometimes does and sometimes does not give an indication of its end use. Where the composition of matter is named in such manner as to indicate the end use, the invention thereof cannot be completed until it is known the composition has the particular end use. An example of such a composition of matter would be a "lubricating oil." Nothing can be a "lubricating oil" until it is known it is an oil and capable of lubricating. Another example is an "insecticidal com-

position." Nothing can be an insecticidal composition until it is known it can kill insects.

Examples of the other type of composition of matter include chemical compounds claimed *per se*. Once whatever the chemist has made in his laboratory is analyzed so there can be no further question as to its identity, then the act of inventing that compound has been completed. The operativeness of the invention (the concept of the compound) has been shown in that it is what it purports to be; it has been proven to exist in tangible, physical form. To go beyond this point and find out what the compound can be used for is a separate operation, which could require the making of additional inventions. An example is "acetylsalicylic acid," which is the name of a chemical compound. That particular chemical compound is more commonly known as aspirin, and the Court is well aware of various ways in which aspirin is used.<sup>20</sup> To observe that aspirin may be administered to relieve pain is a separate and distinct discovery from the act of inventing the chemical compound, aspirin, itself. Until someone first invented and made aspirin, no one could possibly have discovered aspirin could be administered to relieve pain.<sup>21</sup>

Like compositions of matter, a *process* invention may or may not involve tests of the product made by the use of the process in order to know whether the process operates and its invention has been completed. If the particular process is supposed to make a

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<sup>20</sup> The story of aspirin is told in *Kuehmsted v. Farbenfabriken* (CCA 7, 1910), 179 Fed. 701.

<sup>21</sup> New uses for aspirin are still being discovered and patented. *In re Caldwell* (CCPA, 1963), 319 F. 2d 254, 138 USPQ 243.

"lubricating oil," you cannot be sure the process works and has been completed until you know the oil made thereby is capable of lubricating. But if the particular process is supposed to make "aspirin," all you have to do is test the material to identify it as aspirin. Once you are sure of this, you are sure the process works, and that the invention has been completed. That is the situation here. The process claimed by Manson is supposed to make the 2-alpha compound. The process was operated, and the material made was identified as the 2-alpha compound. This established that the process worked to produce the desired product and the invention claimed was thereby completed. Petitioner confuses the process (which is the "invention" here claimed) and the product made therefrom (which is not the "invention" claimed).

(2) Since the Court is here concerned with a process invention, some explanation of the customary relationship of a process and the product made therefrom may prove helpful.

The invention claimed in the Manson application is a process invention. Normally courts distinguish a process from the material made by the use of the process. The exception to the rule is found in *James v. Campbell* (1881), 104 U.S. 356, 376:

"A patent for a process and a patent for an implement or a machine are very different things. *Powder Co. v. Powder Works*, 98 U.S. 126. Where a new process produces a new substance, the invention of the process is the same as the invention of the substance . . ."

Contrary to the situation there referred to, here the new process produces not a "new" but an "old"

or "known" substance, so the invention of the second process for making the old substance could not be the same as the invention of the substance.

The instant situation follows the general rule, which this Court has long recognized, that a process and the product made therefrom are independent of each other. As this Court explained in *Rubber Company v. Good-year*, 9 Wall. (76 U.S.) 788, 796:

"Patentable subjects, as defined by the Patent Law, are 'any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement on any art, machine, manufacture or composition of matter'. A machine may be new and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old and the product new. In that event the latter, and not the former, would be patentable. Both may be new, or both may be old. In the former case both would be patentable; in the latter neither. *The same remarks apply to processes and their results.* Patentability may exist as to either, neither, or both, according to the fact of novelty, or the opposite. The patentability, or the issuing of a patent as to one, in nowise affects the rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts. Such is the sound and necessary construction of the statute." (Emphasis added)

The present 1952 Patent Act differs from the portion of the previous statute referred to in the above quotation only in replacing the term "art" by its synonym "process."

Clearly this Court has long distinguished between a process and the product made by using the process.

The Court of Customs and Patent Appeals also differentiates the invention of a process from the products made thereby, as shown by three recent cases: *In re Larsen* (CCPA 1961) 292 F. 2d 531, 130 USPQ 209; *In re Surrey et al.* (CCPA 1963) 319 F. 2d 233, 138 USPQ 67; *In re Albertson* (CCPA 1964) 332 F. 2d 379, 382, 141 USPQ 730, as well as the decision in the instant case.

It appears that, under the view expressed by this Court, the Court below, and the Patent Office [which was affirmed in the three cases referred to], a process invention is to be differentiated from the product made therefrom. It follows the process can be useful whether the product made therefrom is useful or not. Even the first process of making aspirin did not magically change from a "useless" to a "useful" invention, on the day a use for aspirin was discovered. The useful quality of the process of giving birth remains immutable whether the baby grows up to be a useful citizen or a useless one.

We regard it as anomalous that Petitioner, the Commissioner of Patents, should now take the diametrically opposed position the act of inventing a process cannot be completed until the resultant product has not only been made, but has been found to have a specific independent use. If that is the law, then one process, the process of making a new product, can never be completed until a second and different process, the process of using the new product for a specific purpose, has also been completed.

This Court has previously refused to jumble together processes and products. Thus, it held a new process for producing an old compound could be patentable

in *Cochrane v. Badische Anilin and Soda Fabrik*, (1884) 111 U.S. 293, 311:

“... The article produced by the process described was the alizarine of Madder, having the chemical formula  $C_{14}H_8O_4$ . It was an old article. While a new process for producing it was patentable, the product itself could not be patented, even though it was a product made artificially for the first time, in contradistinction to being eliminated from the Madder root.”

In the case of *The Wood-Paper Patent* (1874) 90 U.S. 566, 593, this Court said:

“The first (no. 1448) is a patent for a product or a manufacture, and not for any process by which the product may be obtained. The second (no. 1449) is for a process and not for a product. It is quite obvious that a manufacture or a product of a process, may be no novelty, while, at the same time, the process for agency by which it is produced, may be both new and useful—a great improvement on any previously known process, and, therefore, patentable as such.”

In *Holland Furniture Company v. Perkins Glue Company* (1928) 277 U.S. 245, 255, this Court said:

“A patentable process is a method of treatment of certain materials to produce a particular result or product. *Cochrane v. Deener*, 94 U.S. 780. The description of one does not necessarily embrace the other. Either or both may be patentable.”

In the instant case the majority of the Court below properly differentiated the “processes” and “products” made thereby, and held Manson could and did

complete the act of inventing his process, without regard to whether the 2-alpha compound produced had a known utility.

**V. Manson's Claimed Process is a Useful Process Since It Makes a Previously Known Compound Which Itself Is Useful Under 35 U.S.C. 101**

The invention here involved is a process for making the 2-alpha compound. If the 2-alpha compound is established to be "useful" as of a date prior to the filing [or priority] date of the Ringold et al. patent, then the process of making such compound would be useful, even under the view of the applicable law asserted by Petitioner,<sup>22</sup> and Manson would have complied with Rule 204(b).

The particular date Manson must beat is 1956 December 17.<sup>23</sup> Manson must prevail if a "use" for the 2-alpha compound was known prior to that priority date. Manson submits an early enough use was known when the journal article (R-59) was published in the November 1956 issue, since it disclosed a use for the 2-alpha compound.<sup>24</sup>

The Court is aware that, by definition, the nature of any "chemical compound" is such that each molecule is the same and acts the same no matter how made or where found. Any batch of a specific chemical compound, whether found in this country or any other country, whether made by a particular process or by

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<sup>22</sup> Pet. Br. p. 28.

<sup>23</sup> This is the date of Ringold et al.'s Mexican application. The Ringold et al. patent was accorded the benefit of this earlier date, under the international convention (R-57).

<sup>24</sup> Manson had actually read this journal article prior to the critical date (R-46).



any other process, will be identical in all respects to any other batch. Once it is definitely established that what the chemist has actually is a particular compound, there is no further question the compound so made will do and act just like any other sample of the compound. This means that, as soon as more of the compound is available, it is automatically apparent the additional amount will do whatever previous amounts of the compound did, and there is no need actually to test it or use it for such purposes. If the 2-alpha compound made as described in the journal article is "useful," then the 2-alpha compound Manson made is equally as useful since it will do precisely the same things.<sup>25</sup> Thus, the test is whether the journal article states a "use" for the 2-alpha compound.

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<sup>25</sup> *Thomas et al. v. Michael et al.* (CCPA, 1948) 166 F.2d 944, 77 USPQ 216, 218:

"Where the utility of a new product produced by a novel process is not known or apparent, a test is required to establish reduction to practice of that process. See *Bogoslowsky v. Huse*, 31 C.C.P.A. (Patents) 1034, 1038, 142 F.2d 75, 78, 61 USPQ 349, 352. But where the utility of an old product produced by a novel process is known, a test is not required to establish reduction to practice of that process. See *Larson v. Eicher*, 18 C.C.P.A. (Patents) 1497, 49 F.2d 1029, 1031, 9 USPQ 461; *Fenton R. Brydle v. Harry H. Honigbaum*, 19 C.C.P.A. (Patents) 773, 54 F.2d 147, 11 USPQ 219; *Kyrides v. Bruson*, 26 C.C.P.A. (Patents) 986, 102 F.2d 416, 41 USPQ 107 . . .

"... Appellants' position, as hereinbefore described, was based solely on the ground that the product of the count was an old composition the utility of which had been known and demonstrated at the time it was prepared by them in June, 1937.

"We are convinced, for the reasons stated, that the utility of the catalyst produced by appellants in carrying out the process of the count on June 17 to 24, 1937 was known not only in the art but also was known to appellants herein; and that the decision of the board requiring a test of the catalyst to effect its reduction to practice was manifestly wrong."

Respondent Manson will here show the 2-alpha compound meets this test under applicable precedents of the Court of Customs and Patent Appeals; this will suffice to prove the *prima facie* case, which is all that is required.<sup>26</sup>

The 2-alpha compound is "useful", since it meets and exceeds the standard of utility required for a chemical compound, as set forth in a viable precedent, *In re Nelson et al* (CCPA, 1960), 280 F. 2d 172, 126 USPQ 242. In the *Nelson* case, the claimed compound (which was a steroid) was found to be useful under 35 U.S.C. 101. There the disclosure of utility was (280 F. 2d at 175):

"The cardiac glycosides, such as digitoxigenin and the like, comprise steroids which contain an OH-group in the 14-position. Important physiological properties are attributed to these steroids. *However, synthetically produced C-19 14-hydroxy-androstenes wherein the double bond is attached to carbon atom 5 have not heretofore been known.*

*A primary object of the present invention is the embodiment of such synthetically-produced compounds corresponding to formula I supra.<sup>1</sup> These new compounds are valuable intermediates in the preparation of steroids wherein a hydroxyl group is present in the 14-position, and of steroids containing a 14, 15-double bond, and of steroids the synthesis of which requires such groupings.*

Conversion of the androstene compounds to produce analogous saturated 14-hydroxy steroids is

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<sup>26</sup> Manson does not here have to argue the correctness of the applicable precedents, but only to show that *one* exists. That is enough to prove Manson's right to be put in interference. Later on perhaps the decision in the interference could be questioned on the ground that the law applied is incorrect, but not at this preliminary stage of the proceedings.

effected by hydroxy steroids is effected by hydro-generating  $\Delta^5$ -double bond, for example by catalytic methods."

The Court held the above-quoted utility was legally sufficient under 35 U.S.C. 101, saying, 280 F. 2d at 180:

"Now let us consider whether applicants' new compounds, the claimed C-19 14-hydroxy-Androstenes, are 'useful' by the legal standards discussed above, according to the information which is given to us in the specification. We are told thereby that these are new androstenes, of a kind never before made (and novelty has not been questioned), that they are of a type which steroid chemists can use in well-known reactions to produce steroids of a class at least some members of which are known to have useful therapeutic properties. Appellents' point is that new 'building blocks' of *value to the researcher* have been supplied which have *utility as intermediates* in the search for cheaper and shorter routes to the synthesis of steroids having therapeutic or similar ultimate utility.

The Patent Office position seems to have been that there must be a presently existing 'practical' usefulness to some undefined class of persons. We have never received a clear answer to the question 'Useful to whom and for what?' Surely a new group of steroid intermediates is *useful to chemists doing research* on steroids, and in a 'practical' sense too. Such intermediates are 'useful' under section 101. They are often actually placed on the market before much, if anything, is known as to what they are 'good' for, other than experimentation and the making of other compounds in the important field of research. Refusal to protect them at this stage would inhibit their wide dissemination, together with the knowledge of them which a patent disclosure conveys, which discl-

sure the potential protection encourages. This would tend to retard rather than promote progress.

The new androstenes, being *useful to research chemists* for the purposes disclosed by appellants, are clearly useful to society and their invention contributes to the progress of an art which is of great potential usefulness to mankind. They are new steroids which in known ways can be made into other steroids, thus furthering the development of this useful art.

We conclude that the claimed compounds are 'useful' within the meaning of section 101 and that there is a disclosure of the utility in the specification."

Compare the situation in *Nelson* with the instant situation. Here the particular utility of the 2-alpha compound disclosed in the journal article (R-59) was that it is a member of a class of steroids at least some members of which are known to have useful therapeutic properties as tumor inhibitors,<sup>27</sup> and that it is being tested for those same therapeutic properties. In the *Nelson* case the steroid compound was to be used as an intermediate to make other compounds which would then be members of the class of steroids at least some members of which were known to have useful therapeutic properties. The utility of the 2-alpha compound steroid of the instant case is more apparent than that of the steroid compound in the *Nelson* case since here the claimed compound itself belongs to a class, closely related members of which

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<sup>27</sup> The use of a compound as a tumor inhibitor in rats was held to be sufficient utility to satisfy 35 U.S.C. 101 in *In re Bergel and Stock* (CCPA 1961) 292 F.2d 955, 130 USPQ 206, whereupon claims to the compound and a process for making the compound were allowed.

are known to have useful therapeutic properties, and itself was being tested.

We have shown that, if the disclosure of the journal article were incorporated in appellants' patent application,<sup>28</sup> and if the 2-alpha compound were novel, it would be held by the court below to have 35 U.S.C. 101 utility. Therefore, the 2-alpha compound has utility and is a useful product under the law.<sup>29</sup> The process of making it is necessarily useful, and Manson's affidavits were clearly sufficient under Rule 204(b).

**VI. Manson's Process is "Useful", As That Term Is Defined In Patent Law, Where It Is a Term of Art**

Petitioner phrases the question in this case as

"Whether a process is 'useful' within the meaning of the Patent Act . . .". (Pet. Br. p. 2)

That question evokes a problem in semantics which permeates this entire case. The words "useful," "useless," "utility," etc. which appear so many times in the various writings filed and cited in this case, have many different meanings and shades of meanings. So much so that "utility" has been called the "chameleon" of the patent law [Burke "Utility of Chemical Inventions: Chameleon of the Patent Law" 43 J.P.

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<sup>28</sup> As shown in footnote 9, *supra*, it is an unwritten part of the disclosure.

<sup>29</sup> Petitioner (Pet. Br. p. 33) seems to concede the law ought allow some patents to be granted upon inventions whose only use is scientific or experimental, "in the sense of a known specific scientific application of the patent as a research device presently capable of beneficial exploitation." That appears to us to be precisely the type of use referred to in the journal article on which Manson relies.

O.S. 205 (1961)]. The words, which are sometimes words of "art" and sometimes not, have different meanings in different contexts, so it is vital to be aware of the exact context. Thus the "utility" referred to in 35 U.S.C. 101 differs from the "utility" referred to in 35 U.S.C. 112 and from the proof of "utility" required to establish an actual reduction to practice.<sup>30</sup> The terms are also used in connection with "infringement" situations, where they have yet different meanings.<sup>31</sup>

The complexities of the terms "useful," "utility," etc., and the many different situations in which they are used in a different manner may further be appreciated from the fact a leading text devotes over 90 pages to the various aspects of the subject.<sup>32</sup>

Petitioner does not apply the terms "useless" and "useful" properly. These are terms of art in Patent Law,<sup>33</sup> having meanings derived from judicial deci-

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<sup>30</sup> A definitive explanation of the distinctions is found in *In re Nelson et al.*, (CCPA, 1960), 280 F.2d 172, 126 USPQ 242, which is the leading case in this area.

<sup>31</sup> *Stow v. Chicago* (1881), 104 U.S. 547, 550: "A patentee who is the first to make an invention is entitled to his claim for all the uses and advantages which belong to it. *Woodman v. Stimpson*, 3 Fish. Pat. Cas. 98."

*Roberts v. Ryer* (1875), 91 U.S. 150, 157: "It is no new invention to use an old machine for a new purpose. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not."

<sup>32</sup> Deller's *Walker on Patents*, 2nd Edition, Sections 83-101, pages 477-571; especially Sections 84, 86, and 89.

<sup>33</sup> "A study of the cases reveals that the legal significance of 'useful' in the patent statute differs from the general conversational connotation of the word." *Cusano v. Kotler* (CA 3, 1947) 159 F.2d 159, 162, 72 USPQ 62.

sions of long standing by judges of recognized special ability in Patent Law. The correct meaning is basically that stated by Justice Story in *Bedford v. Hunt et al.* (C.C. Mass., 1817) Case no. 1,217, 1 Mason 302, 3 Fed. Cas. 37:

“STORY, Circuit Justice, (after stating the facts.) No person is entitled to a patent under the act of congress unless he has invented some new and useful art, machine, manufacture, or composition of matter, not known or used before. By useful invention, in the statute, is meant such a one as may be applied to some beneficial use in society, in contradistinction to an invention, which is injurious to the morals, the health, or the good order of society. It is not necessary to establish, that the invention is of such general utility, as to supersede all other inventions now in practice to accomplish the same purpose. It is sufficient, that it has no obnoxious or mischievous tendency, that it may be applied to practical uses, and that so far as it is applied, it is salutary. If its practical utility be very limited, it will follow, that it will be of little or no profit to the inventor; and if it be trifling, it will sink into utter neglect. The law, however, does not look to the degree of utility; it simply requires, that it shall be capable of use, and that the use is such as sound morals and policy do not discountenance or prohibit.”

An extensive review of other authorities defining “utility” in a similar manner appears in *In re Nelson et al.*, at 280 F. 2d 172, 178-180, 126 USPQ 242, 248-250.

Manson’s process is “useful” both in a patent law sense as well as a non-patent law sense. It is not frivolous or worthless or injurious to the well-being and morality of the public. The process was invented by an expert researcher experienced in research proj-

ects designed to produce new medicinal agents in the field of endocrinology (R-33).<sup>34</sup> Manson was not just "playing games." He was performing scientific work of the highest caliber, which resulted in *an alternative way* to make the 2-alpha compound. Now if anyone wants some 2-alpha compound, there are two ways to make it. Manson's discovery takes away nothing the public had before, but adds another tool to the public's storehouse of technology. This is true "usefulness" in every sense of the word.

Petitioner's Brief p. 25 points out that, prior to 1950, the Patent Office did not reject chemical patents for lack of utility. The Patent Office Board of Appeals specifically said in *Ex parte Watt* (1942), 63 USPQ 163, 165:

"Regardless of whether applicant's compounds could or could not be used in a froth flotation process we are of the opinion that they could be regarded as intermediates in the preparation of other compounds, since it is obvious that any organic compound can be so used. This is a use other than that disclosed by applicant."

The recent decisions of the Court below<sup>35</sup> did not change the law, but only restored it somewhat to what

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<sup>34</sup> Manson is employed by Sterling-Winthrop Research Institute, the research facility of Winthrop-Stearns and Sterling Drug Inc. Ringold et al. is employed by Syntex. These companies are well-known reputable pharmaceutical companies.

<sup>35</sup> Many other recent decisions of the Court below discuss the "utility" of a process, and support Manson's position here, including: *In re Szwarc* (CCPA 1963) 319 F.2d 277, 285, 138 USPQ 208, 214; *In re Wilke et al.* (CCPA 1963) 314 F.2d 558, 563-64, 136 USPQ 435, 442; *In re Adams et al.* (CCPA 1963) 316 F.2d 476, 478, 137 USPQ 333; and, *In re Larsen* (CCPA 1961) 292 F.2d 531, 130 USPQ 209, 211.



it always had been, so far as the definition of "useful" is concerned. For over 150 years the United States patent system operated on the thesis that chemical compounds have inherent utility so they are necessarily useful, and the country prospered. None of the terrible things Petitioner threatens would happen, if the Court affirms the decision below, happened during that long period of time.

#### **VII. Petitioner's Brief Confused the Ringold et al. Patent and Journal Article**

There appears to be a certain amount of confusion in Petitioner's brief because of the fact that "Ringold et al." is both the patentee with whom Manson seeks an interference and the author of the journal article here involved. For all purposes of this case, it is irrelevant and immaterial that the same persons performed both acts. Thus if the Court were to think of the journal article as having been written by "X"; and the patentee with whom Manson seeks an interference as "Y", it would have a true and less confusing picture.

Petitioner confuses the Ringold et al. journal article with the Ringold et al. patent and as a result Petitioner feels that Manson is somehow taking something away from Ringold et al. For example Petitioner's Brief p. 18 says:

"In obtaining a patent upon the process involved in this case to produce such a known organic compound, Ringold and Rosenkranz disclosed a potential therapeutic use for the compound as an inhibitor of the growth of tumors in animal organisms."

That is not true. *The particular utility quoted was disclosed in the journal article [see R-59-60] and not*

in the Ringold et al. *patent*. In the patent (see R-57, column 1, line 21) a different utility statement appears, viz:

“The products of the process of the present invention have a useful high anabolic-androgenic ratio and are especially valuable for treatment of those ailments where an anabolic or anti-estrogenic effect together with a lesser androgenic effect is desired.”

Petitioner's Brief p. 18 goes on to say:

“Respondent seeks a determination that his discovery of the process was prior to Ringold's—and hence that he, rather than Ringold, should be deemed entitled to the process patent. It is common ground that, to prevail, respondent must show that he arrived at a patentable invention prior to Ringold.”

Manson does not have to show he invented his process before Ringold et al. published the journal article describing a different process. Petitioner fails to recognize Ringold et al. made two different inventions; one being the first process of the journal article and the other the alternative process of the patent. Manson only seeks to contest priority of the latter alternative process invention.<sup>36</sup>

#### **VIII. Affirmance of the Decision Below Will Serve The Objectives For Which Our Patent System Was Established**

While we have shown that Petitioner's arguments concerning patentability of processes go to issues not here involved, we are somewhat fearful not to answer them. Further, if the newspaper accounts are cor-

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<sup>36</sup> Ringold et al. likely also made a third distinct invention which Manson is not contesting either, the 2-alpha compound, *per se*.

rect that the Court is examining the entire aspect of "utility" in patent cases, it may welcome our comments. Therefore we will go beyond the facts of this case, and consider the most extreme case that could arise, i.e., the patentability of a new process for making a new compound, for which compound no utility has been found as yet. We submit the present state of the law is such that even this type of a process is useful and, assuming all other statutory requisites have been met, is patentable, and this is a proper result. We submit this is the only result that serves public policy. It does so mainly by encouraging inventors to make early disclosure of their new processes which successfully operate to produce new products.

The sole reason for the existence of our patent system, as stated in the Constitutional provision, is "to promote the progress of science and useful arts." Progress involves a continual advance in which each man builds upon the earlier discovery of another. The progress of science and useful arts is promoted by encouraging inventors to make their inventions known to all, rather than to keep them secret. This disclosure to the public is the *quid pro quo* which is given the public in return for the seventeen year monopoly of the patent. *United States v. Dubilier Condenser Corp.* (1933) 289 U.S. 178, 186.

The Court is well aware that, with few exceptions, inventors will not publish details of their discoveries if doing so would jeopardize their property rights. The desideratum, dissemination of information, will occur only when doing so would not adversely affect the inchoate patent right of the inventor or his assignee. The earlier an inventor publishes his discoveries, the earlier the public gains the knowledge and can use it

as an experimental building block for the creation of further discoveries. Patent applications will be filed earlier, patents will issue earlier and expire earlier, thereafter enabling all to use the specific invention claimed.

Research will be greatly impeded if inventors feel they are required to make two different inventions before they may safely publish on their first discovery. If a chemist would not only have to invent a process for making a new compound, but then separately invent a use for that new compound, unless and until such a use was found the chemist would not publish, since this would start the running of the one year statutory bar period within which he must apply for a patent. If the inventor never found a use for his new compound, why would he ever publish details of his new process? If that were the law, it is most likely that important processes would be permanently lost to the public. Many of today's commercially important processes are derived from, or are themselves processes invented some years ago which made compounds for which no "use" was then known.<sup>37</sup> Certainly such processes were useful and resulted in progress which would not have occurred under the rule of law which Petitioner proposes.

If Respondent is correct that public policy prefers disclosure to secrecy, then his position promotes it and Petitioner's position hinders it.

The Court ought be aware of some of the possible ramifications of the decision in this case on other situations. We have mentioned before the decision below

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<sup>37</sup> Some representative examples include tetraethyl lead (used in gasoline), silicones, polyurethanes (plastics) and uranium.

merely continues the state of the law as it has been. Over the years many of the various problems attendant to knowing when an invention has been "made" have been answered and guidelines have been established by the courts. Petitioner's Brief at page 19 admits courts will be faced with many difficulties if its view is adopted, as to when a sufficient extent of utility has been established for the product in order for a new process to be patented. This could become a serious matter because the question of when an invention has been completed cuts across many other statutes and situations. We will now mention only a few, which are representative of many others:

#### **The TVA Act:**

Title 16 USC 831(r) is a section of the Tennessee Valley Authority Act (there are similar sections in other Acts). It provides that owners of patents infringed by the TVA may sue in United States District Courts for recovery of reasonable compensation; provided, however:

"\* \* \* that the benefits of this section shall not apply to any \* \* \* art [process], discovered or invented by such employee during the time of his employment with the [TVA] Corporation or with the Government of the United States."

The situation could easily arise wherein a chemist discovers and actually successfully performs a new process which makes a novel compound while employed by the Government. Say he even postulates that the compound made by the process is an excellent fertilizer, but neither he nor his coworkers test the utility of that compound for such purpose until after he leaves the employ of the Government. If he later tests and proves

the postulated utility, applies for and obtains a patent with claims to the process, and the TVA uses the claimed process to make the compound, could he not successfully sue the TVA for infringement under the above Act? Under the theory proposed by Petitioner it is submitted he could, because the invention claimed in his patent would not have been "invented", i.e., completed by actual reduction to practice, until after termination of his employment.

### **The Atomic Energy Act:**

Section 152 (42 USC 2182) of the Atomic Energy Act [and similarly Section 305 (42 USC 2457) of the National Aeronautics and Space Act] deals with the ownership of inventions made or conceived under any contract, subcontract, agreement or other relationship with the Atomic Energy Commission. The Board of Patent Interferences is authorized to follow the rules and procedures established for interference cases in determining whether the invention was made or conceived under any relationship with the AEC and NASA.

Suppose a chemist conceives of a new process for making a novel compound while under contract with the AEC, and actually successfully performs the process, but does not know of a use for the resultant compound or does not actually test the compound for any use until after his contract has been terminated. Who would own any patent on the process which the chemist later applied for, where the utility of the compound was not determined until after such contract termination? Petitioner's theory of what the law ought be would give the AEC and NASA no rights in the patent.

### **Infringement Problems:**

Here Manson actually performed the claimed process before the filing date of the Ringold patent. In the event the decision of the Court below is reversed [in effect affirming the decision of the Patent Office Board of Appeals not to declare an interference with the Ringold patent] the patentee Ringold ought have the right to keep all others from practicing the process defined by his patent claims. But how can Ringold keep Manson from repeating exactly what Manson had done before Ringold made his invention? The perfect defense to any infringement action has always been that the alleged infringer is only doing what he did before the patentee made his invention.

It appears adopting Petitioner's position would result in a confusing change in the law that would not benefit the public in any way, but would seriously impair the progress of science and the useful arts, by shrouding new processes in secrecy.

### **CONCLUSION**

Should this Court decide it has jurisdiction to review this case, then for the reasons stated, the judgment of the Court of Customs and Patent Appeals should be affirmed.

Respectfully submitted,

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## APPENDIX TO RESPONDENT'S BRIEF

### I. Statutes And Rules Involved

28 U.S.C. 1254. "Courts of appeals; certiorari; appeal; certified questions" reads:

"Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;" . . .

28 U.S.C. 1255. "Court of Claims; certiorari; certified questions" reads:

"Cases in the Court of Claims may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted on petition of the United States or the claimant;" . . .

28 U.S.C. 1256. "Court of Customs and Patent Appeals; certiorari" reads:

"Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari."

28 U.S.C. 1257. "State courts; appeal; certiorari" reads:

"Final judgments or decrees rendered by the highest court of a State in which a decision could be had, may be reviewed by the Supreme Court as follows:"

\* \* \*

"(3) By writ of certiorari, where the validity of a treaty or statute of the United States is drawn in question or where the validity of a State statute is drawn in question on the ground of its being repugnant to the Constitution, treaties or laws of the United States, or where any title, right, privilege or immunity

is specially set up or claimed under the Constitution, treaties or statutes of, or commission held or authority exercised under, the United States."

28 U.S.C. 2601. "*Appeals from Customs Court decisions*" reads:

"Any party to a proceeding before the Customs Court who is dissatisfied with the decision of such court as to the construction of the law and the facts respecting the classification of imported merchandise and the rate of duty imposed thereon under such classification, or with any other appealable decision of such court, may, not later than sixty days after the entry of the decision, apply to the Court of Customs and Patent Appeals for a review of all questions of law and fact. In cases arising in the Territories and Possessions ninety days shall be allowed for making such application.

The application shall be made by filing in the office of the clerk of the Court of Customs and Patent Appeals a concise statement of errors of law and fact complained of; and a copy of such statement shall be served on the collector, or on the importer, owner, consignee, or agent, as the case may be. Thereupon the Court of Customs and Patent Appeals shall immediately order the Customs Court to transmit the record and the evidence taken, together with a certified statement of the facts involved in the case and the decision thereon; and all the evidence taken by and before the Customs Court shall be competent evidence before the Court of Customs and Patent Appeals. The decision of the Court of Customs and Patent Appeals shall be final unless set aside or modified by the Supreme Court, and the case shall be remanded to the Customs Court for further proceedings to be taken in pursuance of such decision."

35 U.S.C. 134, "Appeal to the Board of Appeals" reads:

"An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal."

35 U.S.C. 141, "Appeal to Court of Customs and Patent Appeals" provides in pertinent part:

"An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, . . ." . . .

35 U.S.C. 144, "Decision on Appeal" reads:

"The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case."

Amended Patent Office Rule 204(b) and (c), 37 C.F.R. 1, 204(b) and (c). By notice published in 29 F.R. 15 866, 15 867, November 26, 1964, Patent Rule 204 was amended, the amended rules to take effect January 1, 1965 and apply to interferences proposed for declaration after that date. The notice read:

"Section 1.20(b) of Title 37 C.F.R. (Patent Rule 204) is amended and new paragraph (c) is added, as follows:

1.204. Interference with a patent; affidavit by junior party.

(b) When the effective filing date of an applicant is three months or less subsequent to the effective filing date of a patentee, the applicant, before the inter-

ference will be declared, shall file an affidavit that he made the invention in controversy in this country before the effective filing date of the patentee, or that his acts in this country with respect to the invention were sufficient to establish priority of invention relative to the effective date of the patentee.

- (c) When the effective filing date of an applicant is more than three months subsequent to the effective filing date of the patentee, the applicant, before the interference will be declared, shall file two copies of affidavits by himself and by one or more corroborating witnesses, supported by documentary evidence if available, setting out a factual description of acts and circumstances which would prima facie entitle him to an award of priority relative to the effective filing date of the patentee, and accompanied by an explanation of the basis on which he believes that the facts set forth would overcome the effective filing date of the patentee. Upon a showing of sufficient cause, an affidavit on information and belief as to the expected testimony of a witness whose testimony is necessary to overcome the filing date of the patentee may be accepted in lieu of an affidavit by such witness. If the examiner finds the case to be otherwise in condition for the declaration of an interference he will consider this material only to the extent of determining whether a date prior to the effective filing date of the patentee is alleged, and if so, the interference will be declared."

Rule 131 of the Rules of Practice of the United States Patent Office in Patent Cases [37 C.R.F. Section 1.131] reads:

"131. Affidavit of prior invention to overcome cited patent or publication. (a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not

claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or their absence satisfactorily explained."

## **II. The Separate Entities Within The Patent Office**

The staff of the Patent Office is provided for and assigned duties by statute.

35 U.S.C. 3, which provides for a Commissioner of Patents, three assistant commissioners and nine examiners-in-chief, reads:

"A Commissioner of Patents, one first assistant commissioner, two assistant commissioners, and nine examiners-in-chief, shall be appointed by the President, by and with the advice and consent of the Senate."

35 U.S.C. 7, which provides for the "Board of Appeals," and also refers to "Primary Examiners," reads:

"The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commis-

sioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

Whenever the Commissioner considers it necessary to maintain the work of the Board of Appeals current, he may designate any patent examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Appeals. Not more than one such primary examiner shall be a member of the Board of Appeals hearing an appeal."

35 U.S.C. 135, which provides for a board of patent interferences (consisting of three examiners of interferences), reads in pertinent part:

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with . . . any unexpired patent, he shall give notice thereof to the . . . applicant and patentee . . . . The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor." . . .

As is evident from the above, while the Commissioner may appoint the various examiners, the examiners of interferences have a different legal status and remain separate and distinct from the primary examiners.

